



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/895,431      | 06/29/2001  | Richard Qian         | 42390P11146         | 8957             |

7590 06/21/2007  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP  
Seventh Floor  
12400 Wilshire Boulevard  
Los Angeles, CA 90025-1026

|          |
|----------|
| EXAMINER |
|----------|

CHEN, TE Y

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2161

|           |               |
|-----------|---------------|
| MAIL DATE | DELIVERY MODE |
|-----------|---------------|

06/21/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/895,431

Applicant(s)

QIAN, RICHARD

Examiner

Susan Y. Chen

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 122-129 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 122-129 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Response to Amendment***

This office action is in response to the amendment filed on April 09, 2007.

Claims 122-129 are newly added and pending for examination. Claims 1-121 have been canceled.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 122-129 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to claims 122 and 126, the claimed "a first television preference for what television media is to be presented" and "a second television preference for how the television media is to be presented" are new matters, because the claimed subject matters are not supported in the instant specification.

As to claim 107-110 and 112-121, these claims have the same defects as their base claims, therefore, are rejected for the same reason.

***Claim Rejections - 35 USC § 112 (continue)***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 122-129 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 122 and 126, applicant fails to define the corresponds among the claimed "a first user preference", "a television", "a second user preference template" and "a computer having a web browser". In addition, it is not understood how to associate a user history template with the claimed television media. As such, they render these claims as indefinite. (For the purpose to advance the procession of instant application, these ambiguously claimed limitations will have no art rejection)

As to claim 107-110 and 112-121, these claims have the same defects as their base claims, therefore, are rejected for the same reason.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2161

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 122-129, are rejected under 35 U.S.C. 103(a) as being unpatentable over Sehr et al. (U.S. Patent No. 6,386,451) in view of Schena et al. (U.S. Patent No. 6,448,979).

As to claims 122 and 126, Sehr discloses an apparatus comprising:

a portable medium having a logic circuit and a machine-readable medium [e.g., the smart card package (11, Fig. 1) has silicon chip/integrated circuit embedded into one package for storing functional data from/to the read/write multi-media devices at col. 6, lines 19-41];

a template database stored in a machine-readable format on the machine-readable medium [e.g., the distributed database (10, 20, 30, Fig. 1) comprising the electronic template files which implement the smart card data, usage and the system's operations as database records at col. 5, lines 15-27], wherein the template database including:

user preference information for media consumption stored in the storage medium [e.g., the downloaded points of interest stored into a smart (or passenger) card at col. 39, lines 51-53];

an analyzer to analyze usage data and dynamically generate usage history [e.g., the use of Audit Trail field at col. 20, lines 3-18 & col. 22, lines 61-65].

Sehr did not specifically cited that the plurality of templates stored in the template database are designed to be compatible with a television and computer.

However, Schena et al. (hereinafter referred as Schena) discloses a system with means comprising the claimed features [e.g., Abstract, col. 5, lines 23 – col. 6, line 17, Fig(s). 1-3 and associated texts].

Sehr and Schena are in the same field of endeavor to optimize the portable device such as smart card processing, therefore, with the teachings of Sehr and Schena in front of him/her, it would have been obvious for an ordinary skilled person in the art at the time the invention was made to apply the well known technique as disclosed by Schena into Sehr portable device processing system, because by doing so as suggested by Schena, the combined will be upgraded to provide a virtual world presentation including Internet, advertising, entertainment and electronic commerce to end user such that the combined system enables those controlling of printable media to the customer over multimedia devices [e.g., Schena: col. 1, lines 26 –57].

As to claims 123 and 127, except the features disclosed on claims 122 and 126, the combined system of Sehr and Schena further discloses the system stores credit card information [e.g., Sehr: col. 6, lines 19-25].

As to claims 124 and 128, except the features disclosed on claims 122 and 126, the combined system of Sehr and Schena further discloses the system stores entertainment media content [e.g., Schena: col. 1, lines 26-33, col. 3 lines 8-20]

As to claims 125 and 129, except the features disclosed on claims 122 and 126, the combined system of Sehr and Schena further discloses the storage media comprises a flash memory [e.g., the claimed feature is met by the nature of multimedia].

### ***Response to Arguments***

Applicant's arguments with respect to claims 122-129 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 2161

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Points of Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y. Chen whose telephone number is 571-272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mofiz Apu can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Susan Y Chen  
Examiner  
Art Unit 2161





Application/Control Number: 09/895,431  
Art Unit: 2161

Page 8

June 11, 2007